

**REMARKS****A. Claim to Priority**

The Office Action acknowledges that a claim to priority was made by Applicant based on an application filed in France on December 5, 2002. However, the Office Action indicates that a certified copy of the French application pursuant to 35 U.S.C. §119(b) was not received.

Applicant, however, respectfully notes that the certified copy was filed on December 4, 2003. Additionally, a second certified copy was filed on June 15, 2005, and a certified copy has been scanned into the Public PAIR system and can now be found in the Image file wrapper. Accordingly, Applicant asserts that the certified copy has been provided, and acknowledgment by the Examiner is respectfully requested.

**B. Status of the Claims and Explanation of the Amendments**

Prior to the submission of this paper, claims 1, 2 and 4-10 were pending. In this paper, Applicant respectfully requests the cancellation of claims 6-10, and the addition of new claims 11-14. Upon the entry of these amendments, claims 1, 2, 4, 5, and 11-14 will be presented for examination.

Support for new claims 11-14 generally can be found throughout the specification. See, e.g., page 2, lines 18-21, and page 4, lines 1-10.

Claims 1, 2, 5-8, and 10 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicant's alleged "admissions" in view of JP 2000- 176659 to Hideji ("Hideji"). Claim 4 has been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Applicant's alleged "admissions, in view of Hideji, and in further view of US. Patent No.

5,614,338 to Pyburn et al. ("Pyburn"). Claim 9 has been rejected under 35 U.S.C. § 103(a) over Applicant's alleged "admissions" and Hideji, in view of U.S. Patent No. 5,149,589 to Naritomi ("Naritomi").

C. Applicant's Claims Are Patentable

Applicant respectfully traverses the above-mentioned rejections of Applicant's claims under 35 U.S.C. §103(a), for several reasons. First, the Office Action has failed to provide a proper rejection under 35 U.S.C. §103(a). Second, the Office Action has improperly applied the standards set forth in MPEP §2144.04 in rejecting Applicant's claims. Accordingly, the rejections of Applicant's claims under 35 U.S.C. §103(a) should be withdrawn.

1. None of the Office Actions Issued So Far Have Provided Any Proper Motivation to Combine the Applicant's Alleged "Admissions" and the Hideji

According to MPEP §706.02(j), a proper rejection under 35 U.S.C. §103(a) requires the following four components:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

However, in the two office actions issued so far in the examination of this case (viz., on February 8, 2005 and August 25, 2005), a proper rejection under 35 U.S.C. §103(a) has not yet been provided. In both office actions, Applicant's claims 1-3, 5-8, and 10 were rejected

over an alleged “admission” by Applicant, in view of Hideji.<sup>1,2</sup> The rejections were identical in both Office Actions and read as follows:

Applicant admits that motor manufactures [sic] very often require there to be particular motifs or patterns on lighting and indicating devices. The motifs are provided for aesthetic purposes and are obtained by deposition of inks or paint on the component to be decorated (see pages 1 lines 10-22 of the specification).

Applicant does not admit that it is known to form the decorative motif on such components by metallizing said component and exposing at least one surface of the component to laser radiation. However, Hideji teaches a method of providing motifs to a variety of transparent materials (005) by bonding a metallic foil (herein understood to read on “metallizing”) and carrying out evaporation scattering of the metallic foil with a laser marker to obtain the desired motif (005). The laser utilized is preferably a YAG laser (0006). The metal layer may also be vacuum deposited (0010).

With respect to claims 2, 8, and 10.... [Office Action of February 8, 2005 at item 6 and Office Action of August 25, 2005 at item 4].

The first two paragraphs apparently refer to the rejection of claims 1 and 5-7, because the third paragraph specifically refers to the rejection of claims 2, 8, and 10. The rejection of claims 1 and 5-7 set forth in the first two paragraphs, however, is defective. At best, it is a mere recitation of certain technical features of the alleged “admission” and Hideji. The rejection does not, for example, explain how one must modify either reference to arrive at Applicant’s invention. For at least this reason, it does not satisfy the requirements set forth in MPEP §706.02(j).

Even more importantly, the two paragraphs that constitute the rejection of claims 1 and 5-7 provide absolutely no motivation to combine the references. The current case law

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<sup>1</sup> In the Office Action of August 25, 2005, the rejected claims were actually claims 1, 2, 5-8, and 10. Claim 3 was not rejected, presumably because it had been cancelled without prejudice by Applicant.

<sup>2</sup> In this response, Applicant uses the terminology that the Office Action uses, for the sake of consistency. However, Applicant emphatically maintains that Applicant has not “admitted” anything, notwithstanding the Office Action’s assertions to the contrary.

clearly requires a suggestion or motivation to modify the references or combine the reference teachings. See MPEP §2143. Here, however, after carefully parsing each of the seven sentences that together constitute the two-paragraph rejection of claim 1 and 5-7, Applicant does not see any language that provides a motivation to combine or to modify the references. Again, the sentences are, at best, a mere recitation of certain technical features of the alleged “admission” and Hideji.

Applicant further notes that the statements in the Office Action’s “Response to Arguments” (August 25, 2005 Office Action page 5) do not provide any motivation to combine the references either. According to the Office Action, “[t]he examiner initially notes the teachings of Hideji are not limited to portable telephone sets”. This statement, in and of itself, is not enough to sustain a proper rejection under 35 U.S.C. §103(a). As MPEP §2143.01 makes clear, “[t]he mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination”. The Office Action has not shown that the references suggest the desirability of the combination.

Furthermore, the Office Action’s statement that “Hideji is analogous because said teachings are reasonably pertinent to the problems faced by the invention – the application of an aesthetic metallic motif on a transparent plastic substrate” does not provide motivation either. Both Office Actions for this case have failed to point out where there is any teaching or suggestion of metallizing an element of a lighting or indicating apparatus (i.e., a “component” as recited in Applicant’s claims) and selectively removing the metal using laser radiation. According to *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992), “[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of

invention would make the combination. That knowledge can not come from the applicant's invention itself.” On this basis, Applicant respectfully asserts that the Office Action’s argument is based on impermissible hindsight reasoning.

Accordingly, Applicant requests reconsideration and withdrawal of the rejection of claims 1 and 5-7 under 35 U.S.C. §103(a) as allegedly being unpatentable over the alleged “admissions” and Hideji.

With respect to the rejection of claim 2, Applicant maintains that all of the comments made above in connection with claim 1 apply with equal force, as claim 2 depends from claim 1.

Additionally, Applicant respectfully traverses the rejection of claim 2 based on MPEP §2144.04, as set forth, for example, on page 3 of August 25, 2005 Office Action. This obviousness rejection is defective in at least two ways. First, none of the cited references teaches, discloses, or suggests all of the claim elements, as required by MPEP §2143.03. In fact, the Office Action itself concedes this point by stating that “Applicant does not admit nor does Hideji teach that a ‘plurality of surfaces’ may be exposed to laser radiation to produce the desired motif” [see August 25, 2005 Office Action, at page 3]. Moreover, Applicant respectfully asserts that the limitations on the patentability of aesthetic design changes as set forth in MPEP §2144.04 apply only to composition or apparatus claims, and not to the steps of a method claim, such as claim 2. Otherwise, if one were to invent a new method of decorating a known object or material, one could not obtain a patent on it. However, this is not the case. For example, in U.S. Patent 4,183,986, claim 1 is directed to a process for making a sheet of artificial leather (which can be cut up for use as watch bands)) that involves embossing a laminate material to give it the look of artificial leather.

In summary, the Office Action has not provided any proper motivation to combine or to modify the cited references, and apparently has relied on impermissible hindsight to arrive at Applicant's invention. Accordingly, the rejections of claims 1, 2, 5-8, and 10 over the alleged "admissions" in view of Hideji should be withdrawn. Reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

2. Claims 4 Is Patentable Over the Cited References

In rejecting claim 4, the Office Action relies on the alleged "admissions" and Hideji for all of the claim elements, with the exception of modification of the surface color of a polymer by exposure to laser radiation. The Office Action concedes that the alleged "admissions" and Hideji fail to disclose this claim element, and accordingly relies on Pyburn.

Applicant, however, has previously shown above that there is no proper motivation to combine the alleged "admissions" and Hideji. Further, it appears that Pyburn does not alleviate the deficiencies of these references. Accordingly, the rejection of claim 4 should be withdrawn.

3. Claims 9 Is Patentable Over the Cited References

In rejecting claim 9, the Office Action relies on the alleged "admissions" and Hideji for all of the claim elements, with the exception of the use of a thermoplastic. The Office Action concedes that the alleged "admissions" and Hideji fail to disclose this claim element, and accordingly relies on Naritomi.

Applicant, however, has previously shown above that there is no proper motivation to combine the alleged "admissions" and Hideji. Further, it appears that Naritomi

does not alleviate the deficiencies of these references. Accordingly, the rejection of claim 4 should be withdrawn.

**CONCLUSION**

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

**AUTHORIZATION**

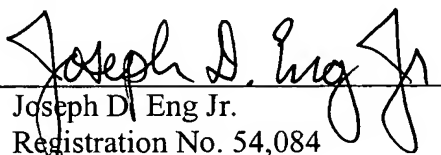
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 1948-4825. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 1948-4825. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: November 23, 2005

By: \_\_\_\_\_

  
Joseph D. Eng Jr.  
Registration No. 54,084

**Correspondence Address:**

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 Telephone  
(212) 415-8701 Facsimile